

REMARKS

Claims 1, 3-7 and 10-21 are pending. Applicants have amended claims 1 and 3 to address certain informalities. Applicants have cancelled claims 4, 10-12 and 20. Upon entry of this Amendment, claims 1, 3, 5-7, 13-19 and 21 will be pending and under examination.

35 U.S.C. §103

The Examiner maintained the rejection of claims 1, 3-7 and 10-21 under 35 U.S.C. §103 as allegedly obvious over U.S. Patent No. 6,303,141 ("141 patent") in view of EP '430. Applicants note that claims 4, 10-12 and 20 have been cancelled, rendering the rejection thereof moot.

In response to the rejection of the remaining claims, applicants respectfully traverse.

The claimed system comprises, in relevant part, an ACE inhibitor that is in the form of a dicarboxylic acid that is derivatized to form a diester. This invention unexpectedly overcomes the difficulty of obtaining ACE inhibitors which (i) remain stable with respect to decomposition in a transdermal system and (ii) exhibit outstanding skin permeation. Applicants' remarks and declaratory evidence in support of this position are set forth in their previous Amendment.

In the Office Action, the Examiner's rejections appear to be based on the belief that the cited art renders obvious the embodiment of the claimed system wherein the ACE inhibitor is in the form of a monosalt formed with acids. Additionally, the Examiner finds the September 4, 2008 Declaration of J. Nink insufficient to overcome the obviousness rejection because, according to the Examiner, applicants "compared dicarboxylic diester with the monoester, while the scope of the claims further encompass [sic] monosalts with acids. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims."

Based on these and other comments by the Examiner, applicants understand the Examiner's position to be that the claims would be allowable were the claimed system to comprise an ACE inhibitor in the form of a

dicarboxylic acid that is derivatized to form a diester, but not an ACE inhibitor in the form of a monosalt formed with acids.

Without conceding the correctness of the Examiner's rejection or any remarks supporting same, applicants note that the inhibitor in the claimed system is an ACE inhibitor in the form of a dicarboxylic acid that is derivatized to form a diester.

Accordingly, applicants maintain that the cited references fail to create a reasonable expectation of success regarding the unexpected properties of the claimed system, particularly in view of the submitted Declaration.

For the above reasons, applicants maintain that the claimed invention is not obvious.

If any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE LLP

By /Alan J. Morrison/
Alan J. Morrison
Reg. No. 37,399
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: March 30, 2009